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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,726	01/22/2001	Carolyn Pianin	21300.105005	1308
20786	7590	11/29/2004	EXAMINER	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. ATLANTA, GA 30303-1763			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,726

Applicant(s)

PIANIN, CAROLYN

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

This is in reference to preliminary amendment received on April 9, 2001. There are 10 claims, claims 1 – 10 pending for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark US Patent 6,351,738 in view of Barnes et al. US Patent 5,970,475 hereinafter known as Barnes.

Regarding claim 1, Clark teaches system and method for obtaining a service in support of commercial real estate transactions (field of use), Clark teaches:

providing a virtual marketplace for commercial real estate service providers using a distributed computer network [Fig. 4], wherein users requiring commercial real estate

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services (field of use) can access the marketplace and can electronically request information on commercial real estate services from a service provider; and

responding to requests for information on commercial real estate services (product) by electronically providing requested information at the virtual marketplace (The HBE e-commerce system will link the HBE, selected suppliers, participants and customers in an essentially paperless network of commerce). Clark does not teach requested information is published as one of textual information or links to commercial real estate service provider web sites. However Barnes teaches electronically providing requested information at the virtual marketplace wherein the requested information is published as one of textual information (A communication link is provided for selectively accessing, for viewing and downloading by a user, information from the supplier's catalog to the user's terminal).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark as taught by Barnes to allow the customer to do research about the service provider.

Claims 2 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark US Patent 6,351,738 in view of Barnes et al. US Patent 5,970,475 hereinafter known as Barnes and Mandler et al. US Patent 6,785,661 hereinafter known as Mandler.

Regarding claim 2, Clark in view of Barnes does not teach responding to requests for quotes on commercial real estate services or products by providing cost estimates for specified services or products based on criteria provided by participating service providers. However, Mandler teaches system and method responding to requests for quotes on commercial real estate services or products by providing cost estimates for specified services or products based on criteria provided by participating service providers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark in view of Barnes as taught by Mandler to inform the customer on how much will it cost them to acquire the product or services from the supplier.

Regarding claim 3, Clark in view of Barnes and Mandler teaches matching users in need of commercial real estate services or products with vendors of the needed commercial real estate services or products based on criteria provided by users and service providers.

Regarding claim 4, Clark in view of Barnes and Mandler teaches concluding the transaction by providing a means for a user in need of commercial real estate services or products to electronically purchase the services or products.

Regarding claim 7, Clark in view of Barnes and Mandler teaches due diligence service comprises an engineering service, environmental service, or an appraisal service (field of use).

Regarding claim 8, Clark in view of Barnes and Mandler teaches engineering service comprises a property condition report (product supplied by purchaser).

Regarding claim 9, Clark in view of Barnes and Mandler teaches environmental service comprises a Phase I, Phase II, or Phase III environmental assessment (product supplied by purchaser).

Regarding claim 10, Clark in view of Barnes and Mandler teaches appraisal service comprises a property valuation report (product supplied by purchaser).

Regarding claim 5, Clark teaches system and method for an on-line process for completing a transaction for a commercial real estate service via a distributed computing environment. Clark teaches:

responding to electronic requests from users seeking commercial real estate services (field of use).

providing a means for a user seeking commercial real estate services to purchase selected commercial real estate services.

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Clark does not teach supplying information on user specified commercial real estate services and commercial real estate service providers. However, Barnes teaches supplying information on user specified commercial real estate services and commercial real estate service providers

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark as taught by Barnes to allow the customer to do research about the service provider.

Clark in view of Barnes teaches providing users with links to commercial real estate service provider information web pages.

Clark in view of Barnes does not teach responding to electronic requests for a quote on commercial real estate services by providing a cost estimate of services based on previously supplied commercial real estate service provider information; However, Mandler teaches system and method responding to electronic requests for a quote on commercial real estate services (field of use) by providing a cost estimate of services based on previously supplied commercial real estate service provider information;

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark in view of Barnes as taught by Mandler to inform the customer on how much will it cost them to acquire the product or services from the supplier.

Regarding claim 6, Clark teaches process for providing due diligence services for commercial real estate transactions (field of use) using a distributed computer network.

Clark teaches:

providing a means for a user in need of due diligence services to purchase specified due diligence services in an on-line environment.

Clark does not teach matching a user in need of due diligence services with a provider of due diligence services by displaying providers of the requested due diligence services to the user. However, Barnes teaches matching a user in need of due diligence services with a provider of due diligence services by displaying providers of the requested due diligence services to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark as taught by Barnes to allow the customer to do research about the service provider.

Clark in view of Barnes teaches providing users with links at a Web site to providers of engineering, environmental, and appraisal services;

matching a user in need of due diligence services with a provider of due diligence services by displaying providers of the requested due diligence services to the user; and

Clark in view of Barnes does not teach responding to requests for quotes on due diligence services by supplying at the Web site a price estimate for specified services by comparing the service requested by a user with a service provider's price for the requested service and displaying the service provider's price for the requested service. However, Mandler teaches responding to requests for quotes on due diligence services

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by supplying at the Web site a price estimate for specified services by comparing the service requested by a user with a service provider's price for the requested service and displaying the service provider's price for the requested service;

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Clark in view of Barnes as taught by Mandler to inform the customer on how much will it cost them to acquire the product or services from the supplier.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Ginter et al. US Patent 5,892,900.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig". The signature is stylized with a large, sweeping initial "N" and a distinct "V" at the end.

Naresh Vig
Patent Examiner
November 22, 2004